

REMARKS

Claims 1-11 are pending. Claims 1 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Minowa et al. (6,243,637) in view of Narita (5,241,477). Claims 2-5 and 7-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Minowa et al. in view of Narita and Vilim et al. (5,745,382).

Rejection of Claims 1 and 6:

According to MPEP § 2142, “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (Emphasis added). “[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” MPEP § 2142 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The Examiner has not shown that all elements and limitations of Applicant’s Claims 1 and 6 are taught by the prior art. Therefore, because elements of Applicant’s invention were unknown in the prior art, the Examiner cannot support a *prima facie* case of obviousness.

Claims 1 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Minowa et al. in view of Narita. The rejections of Claims 1 and 6 are improper because the Examiner erred in setting forth the scope and content of the prior art by erroneously identifying elements of Applicant’s claims in the prior art, and the Examiner thus erred in setting forth the differences between the prior art and the Claimed invention.

Claim 1 requires “determining the first derivative with respect to time of at least a portion of the off-going clutch pressure command; and determining when the on-coming clutch gained torque capacity using the first derivative.” The Examiner admits that “Minowa et al does not show determining when the clutch gained torque capacity using the first derivative with respect to time.” Office Action, page 3. The Examiner then states that “Narita et al shows when the clutch gained torque capacity using the first derivative (Fig 11, Col 3, lines 60- Col 4, lines 25; Col 9, lines 53-64); the first derivative with respect to time (Col 7, lines 5-10 where the data points are plotted with respect to recorded time; Col 2, lines 14-15).”

Notably, the Examiner states only that Narita et al disclose “using the first derivative” and “the first derivative with respect to time.” The Examiner fails to address that the Claim 1 further includes a limitation that the first derivative is “of the off-going clutch pressure command.” (Emphasis added.) The Examiner cannot ignore the actual limitations of Applicant’s Claim 1 by ignoring that Claim 1 requires a time derivative of the pressure command, and not simply a time derivative of anything.

Applicants have reviewed Narita et al. and find no disclosure of “determining the first derivative with respect to time of at least a portion of the off-going clutch pressure command,” as required by Claim 1. (Emphasis added.)

The Examiner is reminded that, under MPEP § 2142: “[R]ejections on obviousness cannot be sustained with mere conclusory statements.” (Emphasis added.) Applicant’s respectfully request that the Examiner show where in Narita, or some other piece of prior art, there is a disclosure of “determining the first derivative with respect to time of ... clutch pressure” Until the Examiner comes forth with a *prima facie* case, Applicant’s are not required to, and are unable to, argue whether or not the prior art renders Applicant’s Claim 1 obvious.

Because neither of the references cited by the Examiner disclose “determining the first derivative with respect to time of ... clutch pressure,” the rejection of Claim 1 is improper and is overcome.

Claim 6 similarly recites “wherein the controller is programmed and configured to determine the first derivative with respect to time of at least a portion of the off-going clutch pressure command; and wherein the controller is programmed and configured to determine when the on-coming clutch gained torque capacity using the first derivative.” Accordingly, the analysis presented for Claim 1 also applies to Claim 6, and therefore the rejection of Claim 6 is also improper, and the rejection thereof is overcome for at least this reason.

Rejection of Claims 2-5 and 7-11:

Claims 2-5 and 7-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Minowa et al. in view of Narita and Vilim et al. (5,745,382).

Claims 2-5 depend from Claim 1 and therefore incorporate all of the elements and limitations of Claim 1. In the rejection of Claims 2-5, the Examiner relies upon Minowa et al. and Narita for all of the elements and limitations of Claim 1. However, as noted above, Minowa et al. and Narita fail to disclose several elements and limitations of Claim 1. Vilim et al. do not teach or suggest the elements and limitations of Claim 1 missing from Minowa et al., and indeed, Vilim et al. does not even address clutch control in a transmission.

Accordingly, the rejections of Claims 2-5 are improper for at least this reason, and are therefore overcome.

Claims 7-10 ultimately depend from Claim 6, and therefore incorporate all of the elements and limitations of Claim 6. As noted above, none of the references cited by the Examiner teach or suggest all of the limitations of Claim 6. Accordingly, the rejections of Claims 7-10 are improper for at least the same reasons that the rejection of Claim 6 is improper.

Claim 11 also requires “determining the first derivative with respect to time of at least a portion of the off-going clutch pressure command, said first derivative being characterized by local minima and maxima; [and] generating a set of data points, each of the data points including a time value and a first derivative value of one of the local minima or maxima.” As

noted above with respect to Claim 1, Minowa et al. and Narita fail to disclose determining the first derivative with respect to time of an off-going clutch pressure command.

In the rejection of Claim 11, the Examiner states that “Narita shows ... first derivative being characterized by local minima and maxima (Col 7, lines 5-10 where the data points are plotted with respect to recorded time in Fig 11; Col 2, lines 14-15)....” Narita states, at column 7, lines 5-10, that “the maximum and minimum of the output shaft torque are given by and stored as T_oPlus and T_oMinus, respectively. The maximum and minimum of the output shaft torque are used in the sub routine of FIG. 8.” (Emphasis added). Thus, Narita discloses, at most, the maximum and minimum values of the output shaft torque. Narita does not disclose the local maxima and minima of the “first derivative with respect to time of at least a portion of the off-going clutch pressure command,” as recited by Claim 11. Furthermore, column 7, lines 5-10 of Narita does not disclose data points “plotted with respect to recorded time.” Accordingly, the rejection of Claim 11 is improper, and is therefore overcome.

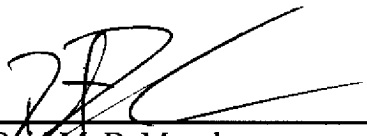
Other reasons for the impropriety of the rejections of Claims 1-11 are present. However, because the rejections are clearly improper for the reasons provided above, further analysis is not necessary.

CONCLUSION

This reply is believed to be fully responsive to the Final Office Action mailed October 28, 2008. The remarks are believed to place this application in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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